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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/509,358 | 09/28/2004 | Masao Komai | KOMAI5 | 2011 |
| 1444 | 7590 | 03/09/2006 | EXAMINER | |
| BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303 | | | SPEER, TIMOTHY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1775 | |
| DATE MAILED: 03/09/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/509,358 | | KOMAI ET AL. | |
| | Examiner | | Art Unit | |
| | Timothy M. Speer | | 1775 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Conner (USPN 3,125,471).

Conner teaches surface treated steel comprising a coating layer consisting of a silicate, wherein the silicate is lithium silicate (col. 1, lines 9-11; and col. 4, lines 31-42). The coating is applied by employing an aqueous silicate solution, as presently claimed, and, accordingly, will exhibit a film thickness after drying of from 10 to 800 mg/m², as presently claimed. Regarding the recitation of intended use in the present claims, viz., that the sheet is "for use in a bearing seal," this limitation is not being given significant patentable weight, since it merely recites a use of the coated steel. Moreover, since the steel of Conner has the same coating as presently claimed, it, too, could be used in such a manner.

With respect to claim 2, the recitation "[a] bearing seal" has not been given patentable weight, because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,

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481 (CCPA 1951). In the present case, the portion of the claim following the preamble does not rely on the preamble for completeness and, accordingly, the preamble is not seen to distinguish over the applied prior art.

In light of the above, it is the Examiner's position that the present claims are anticipated by Conner.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Cole (USPN 5,068,134).

Cole teaches surface treated steel comprising a coating layer consisting of a silicate, wherein the silicate is lithium silicate (col. 2, lines 36-50, for instance). The coating is applied by employing an aqueous silicate solution, as presently claimed, and, accordingly, will exhibit a film thickness after drying of from 10 to 800 mg/m², as presently claimed. Regarding the recitation of intended use in the present claims, viz., that the sheet is "for use in a bearing seal," this limitation is not being given significant patentable weight, since it merely recites a use of the coated steel. Moreover, since the steel of Cole has the same coating as presently claimed, it, too, could be used in such a manner.

With respect to claim 2, the recitation "[a] bearing seal" has not been given patentable weight, because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present case, the portion of the claim following the preamble does not

rely on the preamble for completeness and, accordingly, the preamble is not seen to distinguish over the applied prior art.

In light of the above, it is the Examiner's position that the present claims are anticipated by Cole.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton (USPN 3,180,747).

Patton discloses coating consisting of lithium silicate, but fails expressly to teach such coatings formed on steel substrates (col. 1, lines 9-26, for instance). Patton further teaches that such coatings may be applied to a variety substrates, including metal substrates, in order to impart improved characteristics, e.g., bonding characteristics, to the substrates (col. 3, lines 56-60, for example). Therefore, it would have been obvious to one having ordinary skill in the art to apply the coating of Patton to a steel substrate, since Patton suggests applying such coatings to metal substrates in order to improve the characteristics thereof.

Regarding the presently claimed coating thickness, since the coating of Patton is applied by employing an aqueous silicate solution, as presently claimed, the resultant coating will exhibit a film thickness after drying of from 10 to 800 mg/m², as presently claimed. Regarding the recitation of intended use in the present claims, viz., that the sheet is "for use in a bearing seal,"

this limitation is not being given significant patentable weight, since it merely recites a use of the coated steel. Moreover, since the article of Patton has the same coating as presently claimed, it, too, could be used in such a manner.

Finally, with respect to claim 2, the recitation "[a] bearing seal" has not been given patentable weight, because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present case, the portion of the claim following the preamble does not rely on the preamble for completeness and, accordingly, the preamble is not seen to distinguish over the applied prior art.

In light of the above, it is the Examiner's position that the present claims are obvious in view of Patton.

Response to Arguments

6. Applicant's arguments filed 01/06/06 with respect to Tsutsui (USPN 4,169,916) have been fully considered and are persuasive. Therefore, the rejection of claims 1 and 2 over Tsutsui has been withdrawn. However, upon further consideration, new grounds of rejection have been made in view of Patton, Cole and Conner. These new grounds of rejection were necessitated by applicant's amendments to the claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

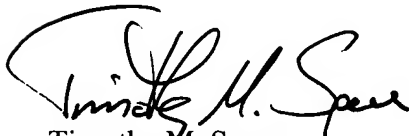
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.

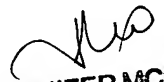
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy M. Speer



JENNIFER MCNEIL
PRIMARY EXAMINER
3/7/06